

**Remarks**

Favorable reconsideration of this application, in view of the above amendments and in light of the following remarks and discussion, is respectfully requested.

Claims 1-25 and 28-32 are currently pending in the application; Claims 1-25 and 28-31 having been amended, Claims 26 and 27 having been canceled without prejudice or disclaimer, and new dependent Claim 32 having been added, by way of the present response.

In the outstanding Office Action correction of the abstract was required; a substitute specification was required; it was advised that the specification should be revised to comply with 35 U.S.C. § 112, first paragraph; Claims 1-31 were rejected under 35 U.S.C. § 112, second paragraph; Claims 1-5, 13-17, and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,914,472 to Foladare et al. (Foladare); Claims 8-12 and 20-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of U.S. Patent No. 6,657,660 to Shiota et al. (Shiota); Claims 6, 7, 18, 19, and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of U.S. Patent No. 6,433,818 to Steinberg et al. (Steinberg); Claims 29 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Foladare and Steinberg, and further in view of Shiota; and Claims 26 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,606,602 to Kolls.

Initially, Applicants respectfully note that although the Office Action appears to indicate that the List of Related Cases filed on December 1, 2003, has been considered, the Office Action does not appear to include an initialed and executed List evidencing consideration of the related case. Thus, Applicants respectfully request an initialed and executed List with the next U.S. Patent and Trademark Office communication.

As stated above correction of the abstract was required. In response, Applicants have amended the abstract so as to include proper contents, as well as to include that which is new in the art to which the invention pertains.

As stated above a substitute specification was required. In response, Applicants respectfully submit herewith substitute and marked-up specifications. Applicants respectfully assert that no new matter has been added to the specification.

As stated above it was advised that the specification should be revised to comply with 35 U.S.C. § 112, first paragraph. In response, Applicants respectfully assert that the substitute specification has been amended so as to comply with 35 U.S.C. § 112, first paragraph, as well as to remedy each of the specific matters noted by the Examiner.

As stated above Claims 1-31 were rejected under 35 U.S.C. § 112, second paragraph. In response, Applicants have extensively amended Claims 1-25 and 28-31 to overcome the rejection under 35 U.S.C. § 112, second paragraph, and so as not to be generally narrative and indefinite, as well as to remedy each of the specific matters noted by the Examiner. Applicants have further canceled Claims 26 and 27. Thus, Applicants respectfully request that the rejection of remaining Claims 1-25 and 28-31 under 35 U.S.C. § 112, second paragraph, be withdrawn.

As stated above Claims 1-5, 13-17, and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Foladare. Claims 8-12 and 20-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Shiota. Claims 6, 7, 18, 19, and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Steinberg. Claims 29 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Foladare and Steinberg, and further in view of Shiota. Claims 26 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kolls. With respect to Claims 26 and 27, Applicants respectfully assert that the rejection has been mooted by the cancellation of

the claims without prejudice or disclaimer. Applicants respectfully assert that the rejections of Claims 1-25 and 28-31 have been overcome by the above amendments to independent Claims 1, 13, 28, and 31, for the following reasons.

Independent Claims 1, 13, 28, and 31 have been amended to recite features similar to those recited in original dependent Claims 8 and 19. Each of Claims 1-25 and 28-31 have been further amended in a non-narrowing manner to remedy potential informalities and to place the claims in better conformity with standard U.S. practice. Therefore, Applicants respectfully assert that support for the changes to the claims is self-evident from the originally filed disclosure, including the original claims, and that therefore no new matter has been added.

The present invention is directed to lending management systems (i.e., independent Claims 1 and 13), lending reservation methods (i.e., independent Claim 28), and computer readable recording mediums for recording a computer program containing instructions configured to provide a lending reservation method (i.e., independent Claim 31).

Independent Claim 1 recites a client terminal connected to a network, and a server terminal connected to the network and configured to be connected to an information device. The client terminal includes an image transmission designating unit configured to transmit an input image data from the information device. Independent Claim 13 recites a client terminal connected to a network, and a server terminal including a server connected to the network, the server terminal configured to be connected to an information device. The client terminal includes an image transmission designating unit configured to transmit an input image data from the information device having image inputting means. Independent Claims 28 and 31 recite authenticating a user, confirming that the reservation is available with respect to the information device, confirming an identity of the user who registers the reservation, and releasing a lock of the information device. Independent Claim 28 and 31 each further recite

designating a method for transmitting an image from the information device after the image device is reconnected to a network used in the lending reservation method.

Foladare is directed to a credit card spending authorization control. Applicants respectfully assert that Foladare does not teach or suggest, however, the claimed features of an image transmission designating unit configured to transmit an input image data from an information device, as recited in independent Claims 1, 13, and does not teach or suggest the claimed features of designating a method for transmitting an image from the information device after the image device is reconnected to a network, as recited in independent Claims 28, and 31.

Specifically, independent Claim 1 recites “the client terminal comprises an image transmission designating unit configured to transmit an input image data from the information device,” independent Claim 13 recites “the client terminal comprises an image transmission designating unit configured to transmit an input image data from the information device having image inputting means,” and independent Claims 28 and 31 recite “designating a method for transmitting an image from the information device after the image device is reconnected to a network used in the lending reservation method.”

Inasmuch as the Office Action may rely on Shiota and Steinberg in the rejections of independent Claims 1, 13, 28, and 31, Applicants respectfully submit the following remarks.

Shiota is directed to a system for storing and utilizing picture image data recorded by a digital camera. Steinberg is directed to a digital camera with biometric security.

Applicants respectfully assert that regardless of the teachings of Shiota and Steinberg, the Office Action has not provided the required motivation to modify Foladare to include such teachings.

As stated in MPEP § 2143.01, “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is

some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves.” In this case, Applicants respectfully assert that the Office Action has not identified the required teaching, suggestion, or motivation to combine the teachings of Foladare, which is directed to a credit card authorization control system that allows parents to control a credit transaction card issued to a child and is not directed to transmitting image data, with the asserted teachings of Shiota and Steinberg, which are directed to digital cameras.<sup>1</sup> Rather, Applicants respectfully assert that the only motivation for combining features of Foladare with Shiota and Steinberg are provided by Applicants’ disclosure.

Thus, inasmuch as any rejections of independent Claims 1, 13, 28, and 31 under 35 U.S.C. § 103(a) in view of one or more of Foladare, Shiota, and Steinberg may be maintained, Applicants respectfully assert that the rejections of the independent claims would be based on the improper application of hindsight considerations. It is well settled that it is impermissible simply to engage in hindsight reconstruction of the claimed invention, using Applicants’ structure as a template and selecting elements from the references to fill in the gaps.<sup>2</sup> Recognizing, after the fact, that a modification of the prior art would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness.<sup>3</sup> Further, Applicants respectfully assert that the “fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness.”<sup>4</sup> Therefore, Applicants respectfully assert that an improper “obvious to try” rationale would be required to maintain

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<sup>1</sup> Applicants respectfully assert that the only motivation offered by the Office Action appears to be on page 7, lines 11-13, of the Office Action, which states “[i]t would have been obvious to incorporate the teachings of Shiota into the disclosure of Foladare so that pictures recorded by a digital camera can be more easily stored and utilized b[y] the user.” As discussed above, however, Applicants respectfully assert that Foladare is not directed to “record[ing] [pictures] by a digital camera,” but rather is directed to a parental control of a child’s credit card usage.

<sup>2</sup> *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

<sup>3</sup> *In re Warner*, 397 F.2d 1011, 154 USPQ 173 (CCPA 1967).

<sup>4</sup> See Heading under MPEP 2143.01.

the rejections in the Office Action.<sup>5</sup> Specifically, Applicants respectfully assert that none of Foladare, Shiota, and Steinberg teach or suggest the desirability of the claimed features of an image transmission designating unit configured to transmit an input image data from an information device, as recited in independent Claims 1, 13, or of the claimed features of designating a method for transmitting an image from the information device after the image device is reconnected to a network, as recited in independent Claims 28 and 31, in combination with other features of the independent claims. Thus, Applicants respectfully assert that a *prima facie* case of obviousness cannot be maintained. Therefore, Applicants respectfully assert that independent Claims 1, 13, 28, and 31 are allowable over a combination of Foladare, Shiota, and Steinberg.

Applicants respectfully assert that remaining Claims 2-12, 14-25, 29, and 30, as well as new Claim 32, are allowable for the same reasons as the independent claims from which they depend, as well as for their own features. Thus, Applicants respectfully request the allowance of dependent Claims 2-12, 14-25, 29, 30, and 32.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-25 and 28-32 is earnestly solicited.

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<sup>5</sup> See MPEP 2145 X.B.

Application No. 09/753,582  
Reply to Office Action of April 21, 2004

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact the undersigned representative at the below listed telephone number.

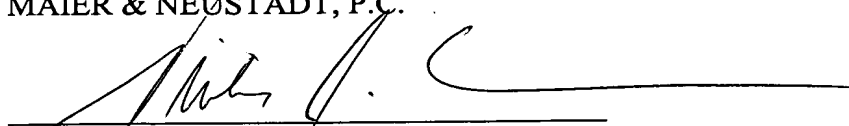
Customer Number

**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 08/03)

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

A handwritten signature in dark ink, appearing to read 'Gregory J. Maier', is written over a horizontal line.

Gregory J. Maier  
Registration No. 25,599  
Attorney of Record

Philip J. Hoffmann  
Registration No. 46,340

GJM/PH/me

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